

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed June 29, 2007 ("Office Action"). At the time of the Office Action, Claims 1-21 were pending in the Application. Claims 1-21 stand rejected. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 112 Rejection

The Examiner rejects Claims 1-6 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner suggests that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art the inventors, at the time the application was filed, had possession of the claimed invention.

There is a recitation of a network element interacting with other components in the network. Rhetorically: Why would this create a problem under §112? If these claims were in a "means plus" function format, then ostensibly Applicant would be required to respond. But Applicant does not appear to be obligated to address this issue at this time.

Section 102 Rejection

The Examiner rejects Claims 1-21 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,269,099 B1 issued to Borella et al. (hereinafter "*Borella*"). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

inherency of that result or characteristic.”³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Oddly, it appears that the Examiner has forgotten to address the back half of Independent Claim 1. Specifically, the Examiner has neglected to examine: “...the network element being further operable to respond to the establishment of the two-way connectivity by constructing a directed graph that includes two nodes representing the first and second autonomous systems respectively, and wherein an edge may be formed that connects the two nodes.” These features are at the end of Independent Claim 1, but the Examiner did not identify any portions of *Borella* that would be pertinent to such capabilities.

At the passages cited by the Examiner for these features, there is nothing germane in *Borella* to such functions. For at least these reasons, Independent Claim 1 is clearly patentable over any of the proffered references. In addition, the other Independent Claims (and their respective dependents) should be allowed for similar or analogous reasons. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



Thomas J. Frame
Reg. No. 47,232

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Customer No. 05073